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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,247	03/17/1999	MAKOTO SATO	35.C13405	3843

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NEW YORK, NY 10112

EXAMINER

VU, NGOC YEN T

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/271,247

Applicant(s)
Makoto SATOH

Examiner
Ngoc-Yen Vu

Art Unit
2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 13, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 ~~is/are~~ pending in the application.
- 4a) Of the above, claim(s) 1-24 ~~is/are~~ withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-46 ~~is/are~~ rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 17, 1999 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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Election/Restriction

1. Claims 1-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made with traverse in Paper No. 8. The Applicant is advised that upon the allowance of a generic claim, the Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement, filed 09/28/00, have been placed in the application file, and the information referred to therein has been considered as to the merits.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29, 36, 39, 40 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites the limitation "said file name" in line 3. There is no antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "the external apparatus" in lines 10-11. There is no antecedent basis for this limitation in the claim.

Claim 39 recites the limitation "said transfer means" in line 2. There is no antecedent basis for this limitation in the claim.

Claim 40 recites the limitation "said file name" in line 3. There is no antecedent basis for this limitation in the claim.

Claim 42 recites the limitation "said file name" in line 2. There is no antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designating the United States and was published under Article 21(2)(a) of such treaty in the English language.

6. Claims 25-27, 30 and 33-35 are rejected under 35 U.S.C. 102(e) as being anticipate by Yamada et al. (US #6,515,697 B1).

Regarding claim 25, Yamada '697 teaches an image transmission apparatus comprising:

transfer means for transferring the information of data amount indicating the data amount of image data to an external apparatus (auxiliary memory MC) (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19);

reception means and receiving from said external apparatus (MC) the signal indicating whether or not said external apparatus admits of the transmission of said image data in accordance with said information of data amount and the free storage capacity of storage means to store said image data in said external apparatus (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19); and

control means (MPU1 & MPU2) for controlling the transmission of said image data in accordance with the signal received by said reception means to indicate whether or not the transmission of said image data is admitted (col. 6 lines 16-27; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 58).

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As to claim 26, Yamada '697 teaches that the signal to indicate whether or not the transmission of said image data is admitted is generated by the manual operation of said external apparatus (Yamada teaches that upon detection of the insertion of the auxiliary memory MC, the control means causes the image data in the main memory (MM) to be transferred and copied to the auxiliary memory MC according to designation of a copy mode; col. 1 lines 50-64, col. 7 lines 26-32, 36-39).

As to claim 27, Yamada '697 teaches that said image transmission apparatus is a digital camera (see Fig. 4, col. 1 lines 12+).

As to claim 30, Yamada '697 teaches the image corresponding to said image data is the image corresponding to a plurality of files, and said signal to indicated whether or not the transfer of said image data is admitted permits the transfer of a part of plural files, but not any transfer of the files other than the part of the file permitted for transfer (col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42).

As to claim 33, Yamada '697 teaches that the digital camera is capable of photographing during the transmission of said image data (col. 7 lines 60-64; col. 9 lines 58-67; col. 12 lines 20-58).

As to claim 34, Yamada '697 teaches means for designating the suspension of the communication (col. 2 lines 4-12; col. 12 line 20 - col. 13 line 30; col. 14 lines 17-26).

As to claim 35, Yamada '697 teaches the image corresponding to said image data is the image corresponding to a plurality of files, and said reception means receives from said external

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apparatus the information indicating the files to be received by said external apparatus, and the information indicating the address of the external apparatus other than said external apparatus, the files to be received by the external apparatus other than said external apparatus (col. 2 lines 4-12; col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42; col. 12 line 20 - col. 13 line 30).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al.

'697 in view of Oie (US #6,188,431).

As to claim 28, the claim differs from Yamada '697 in that it further requires that said transfer means and said reception means perform transfer and transmission by use of cordless line. However, it is well known in the art to transfer image data of a digital camera using cable or cordless line, as taught in Oie '431 (see col. 2 lines 25-27, col. 7 lines 34+). In light of the teaching from Oie, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image transmission apparatus taught in Yamada the capabilities

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of transmitting image data by use of cordless line so as to allow the user freedom to conveniently capture and transmit image data without using a cable.

8. Claims 29 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. '697 in view of Murphy et al. (US #6,282,362).

As to claims 29 and 31-32, the claim differs from Yamada in that it further requires said transfer means performs transfer by adding the thumbnail images having file name corresponding to said image data, wherein said file name indicated the positional information when said image data is photographed, and said transfer means transfers the audio corresponding to said image. The limitations are well known in the art as shown in Murphy '362.

In the same field of endeavor, in figure 2 Murphy '362 teaches a digital camera system 300 comprising a camera body (310), a recording unit (370) and a playback unit (380). Murphy further teaches that the thumbnail image having file names indicated the positional information of the photographed image data can be displayed on the camera viewer (340) (See Fig. 1, playback unit 104 comprises index image 184 and index icon generator 190). Murphy further teaches that audio streams can be digitally stored and play backed via the audio pickup device (172) and an audio transducer (202) (see Fig. 1). In light of the teaching from Murphy, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image transmission apparatus taught in Yamada the capabilities of adding the thumbnail images having audio data and file name indicating the positional information of the photographed image so as to

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provide image data storage in digital format with hype-links between the image and the image location at the time of data capture.

9. Claims 36-38, 41 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. '697 in view of Wakui (US #5,648,816).

Regarding claim 36, Yamada teaches an image reception apparatus comprising:

reception means to receive the information of data amount indication the data amount of image data; detection means to detect the free storage capacity of storage means to store said image data (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19);

output means to output the indication screen to indicate the reception of said image data in accordance with said information of data amount and said free storage capability (see Figs. 6-9 and 11);

transmission means to transmit to an external apparatus the signal to indicate whether or not said image data are required in accordance with the reception indication of said image data (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19); and

image reception means to transmit to said external apparatus the signal to indicated whether or not said external apparatus admits of the transmission of said image data (col. 6 line

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61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19).

Claim 36 differs from Yamada in that the claim further requires the image reception means receive from said external apparatus the image data in accordance with said transmission. However, it is well known in the art to provide a digital camera with the capability of receiving and reproducing image data stored in an external recording medium, as taught in Wakui '816 (see col. 11 lines 14-64). In light of the teaching from Wakui, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the electronic camera taught in Yamada the capabilities of receiving image data from an external apparatus so as to provide the electronic camera with both image data recording and reproducing capabilities.

As to claim 37, Yamada '697 teaches that the signal to indicate whether or not the transmission of said image data is admitted is generated by the manual operation of said output means (Yamada teaches that upon detection of the insertion of the auxiliary memory MC, the control means causes the image data in the main memory (MM) to be transferred and copied to the auxiliary memory MC according to designation of a copy mode; col. 1 lines 50-64, col. 7 lines 26-32, 36-39).

As to claim 38, Yamada '697 teaches that said image transmission apparatus is a digital camera (see Fig. 4, col. 1 lines 12+).

As to claim 41, Yamada '697 teaches the image corresponding to said image data is the image corresponding to a plurality of files, and said signal to indicated whether or not the transfer

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of said image data is admitted permits the transfer of a part of plural files, but not any transfer of the files other than the part of the file permitted for transfer (col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42).

As to claim 44, Yamada '697 teaches that the digital camera is capable of photographing during the transmission of said image data (col. 7 lines 60-64; col. 9 lines 58-67; col. 12 lines 20-58).

As to claim 45, Yamada '697 teaches means for designating the suspension of the communication (col. 2 lines 4-12; col. 12 line 20 - col. 13 line 30; col. 14 lines 17-26).

As to claim 46, Yamada '697 teaches the image corresponding to said image data is the image corresponding to a plurality of files, and said reception means receives from said external apparatus the information indicating the files to be received by said external apparatus, and the information indicating the address of the external apparatus other than said external apparatus, the files to be received by the external apparatus other than said external apparatus (col. 2 lines 4-12; col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42; col. 12 line 20 - col. 13 line 30).

10. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. '697 in view of Wakui '816, as applied to claim 36, and further in view of Oie (US #6,188,431).

As to claim 39, the claim differs from Yamada, as modified by Wakui, in that it further requires that said transfer means and said reception means perform transfer and transmission by

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use of cordless line. However, it is well known in the art to transfer image data of a digital camera using cable or cordless line, as taught in Oie '431 (see col. 2 lines 25-27, col. 7 lines 34+). In light of the teaching from Oie, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image transmission apparatus taught in Yamada the capabilities of transmitting image data by use of cordless line so as to allow the user freedom to conveniently capture and transmit image data without using a cable.

11. Claims 40 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. '697 in view of Wakui '816, as applied to claim 36 above, and further in view of Murphy et al. (US #6,282,362).

As to claims **40** and **42-43**, the claim differs from Yamada, as modified by Wakui, in that it further requires said transfer means performs transfer by adding the thumbnail images having file name corresponding to said image data, wherein said file name indicated the positional information when said image data is photographed, and said transfer means transfers the audio corresponding to said image. The limitations are well known in the art as shown in Murphy '362.

In the same field of endeavor, in figure 2 Murphy '362 teaches a digital camera system 300 comprising a camera body (310), a recording unit (370) and a playback unit (380). Murphy further teaches that the thumbnail image having file names indicated the positional information of the photographed image data can be displayed on the camera viewer (340) (See Fig. 1, playback unit 104 comprises index image 184 and index icon generator 190). Murphy further teaches that

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audio streams can be digitally stored and play backed via the audio pickup device (172) and an audio transducer (202) (see Fig. 1). In light of the teaching from Murphy, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image transmission apparatus taught in Yamada and Wakui the capabilities of adding the thumbnail images having audio data and file name indicating the positional information of the photographed image so as to provide image data storage in digital format with hype-links between the image and the image location at the time of data capture.

Conclusion

12. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

(for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,
Sixth Floor (Receptionist).

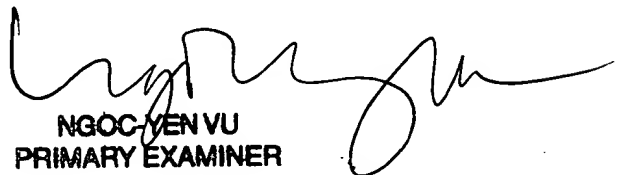
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ngoc-Yen Vu** whose telephone number is (703) 305-4946. The examiner can normally be reached on Mon - Fri from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

NYV
03/22/2003


NGOC-YEN VU
PRIMARY EXAMINER